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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/600,391 | 06/20/2003 | Andreas Nickel | BAYER 10260-WCG | 8238 |
| 27386 | 7590 | 06/03/2009 | EXAMINER | |
| NORRIS, MC LAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022 | | | NAGPAUL, JYOTI | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/600,391 | NICKEL ET AL. | |
| | Examiner | Art Unit | |
| | JYOTI NAGPAUL | 1797 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 May 2009.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2,4-11,13-16,26 and 27 is/are pending in the application.
 4a) Of the above claim(s) 18-25 and 28 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 2,4-11,13-16,26 and 27 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Amendment filed on May 12, 2009 has been acknowledged. Claims 2, 4-11, 13-16 and 26-27 are pending. Claims 18-25 and 28 are withdrawn as being directed to a non-elected invention as indicated in Office Action filed on December 11, 2008.

Response to Amendment

Rejection of Claims 4-5, 8-11 and 26-27 as being unpatentable over Kalthod (US 5,779,897) in view of McGinnis (US 3690465) and further in view of Prasad (US 5352361) has been modified in light of applicants' amendments.

Rejection of Claims 2, 6-7 and 12 as being unpatentable over Kalthod (US 5,779,897) in view of McGinnis (US 3690465) and further in view of Prasad (US 5352361) as applied to claim 5 above, and further in view of Taketomo has been modified in light of applicants' amendments.

Rejection of Claims 13-14 as being unpatentable over Kalthod (US 5,779,897) in view of McGinnis (US 3690465) and further in view of Prasad (US 5352361) as applied to claim 27 above, and further in view of Shay (US 4310607) has been modified in light of applicants' amendments.

Rejection of Claim 15 as being unpatentable over Kalthod (US 5,779,897) in view of McGinnis (US 3690465) and further in view of Prasad (US 5352361) as applied to claim 27 above, and further in view of Bellhouse (US 6217764) has been modified in light of applicants' amendments.

Rejection of Claim 16 as being unpatentable over Kalthod (US 5,779,897) in view of McGinnis (US 3690465) and further in view of Prasad (US 5352361) as applied to

claim 27 above, and further in view of Dobo (US 4268278) has been modified in light of applicants' amendments.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. **Claims 4-5, 8-11 and 26-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalthod (US 5,779,897) in view of McGinnis (US 3690465) and further in view of Garcera (US 4640774).

As for claims 4-5 and 8-11, Kalthod teaches a fluid separation module comprising at least one bundle of ceramic capillaries (27). (See Col. 9, Lines 9-12) The capillaries (27) having an external diameter in the range of 0.3 mm to 10mm and internal diameter in the range of 0.1 mm to 8mm. (See Col. 5, Lines 60-64)

Kalthod fails to teach a distance is established between the capillaries by attaching staggered ceramic film strips to the capillaries while the capillaries are parallel, winding the capillaries into a bundle and joining the ending of the bundle of capillaries in an end plate through which their ending pass at a defined distance from each other. The staggered ceramic film strips define a distance between the individual capillaries in the bundle and also form baffle plates within the bundle.

McGinnis teaches the making of a separation module. McGinnis teaches capillaries (14) that are laid side by side in a spaced apart relationship. The capillaries are wound into a bundle and then joined at the ending of the bundle of capillaries (14) in an end plate/perforated plates (19). (See Figures 1 and 9-11) (See Col. 14, Lines 12-15)

The fabrication of capillary bundles in the method described by McGinnis is conventionally known in the art. Kalthod further discloses introducing the filament in a filament winding machine and then into a mandrel as it is rotated. (See Col. 5, Lines 6-8) Thus it would have been obvious to one having ordinary skill in the art to fabricate

the device of Kalthod as described in McGinnis to achieve the predictable results of proper alignment of the hollow fibers.

Kalthod and McGinnis both fail to teach attaching staggered ceramic film strips while the capillaries are parallel and further, the staggered ceramic film strips define a distance between the individual capillaries in the bundle and also form baffle plates within the bundle.

Garcera teaches separation module comprising a tape of ceramic paste for holding the filter members (3) so that they don't move under the effect of pressure differences, pressure rises and falls, occasional hammering or shock waves, and also differential thermal expansions. (See Col. 6, Lines 64-66 and Col. 7, Lines 13-26)

It would have been obvious to one having ordinary skill in the art to provide the device of Kalthod in view of McGinnis with staggered ceramic film strips while the capillaries are parallel so that they don't move under the effect of pressure differences, pressure rises and falls, occasional hammering or shock waves, and also differential thermal expansions as disclosed in Garcera.

2. **Claims 2, 6-7 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalthod (US 5,779,897) in view of McGinnis (US 3690465) and further in view of Garcera (US 4640774) as applied to claim 5 above, and further in view of Taketomo.

Refer above for the teachings of Kalthod, McGinnis and Garcera.

Kalthod, McGinnis and Garcera fail to teach the distance is less than 3 mm.

Taketomo teaches a separation module. The module comprises a sheet/spacers (26) at several points along the length of the capillaries so that the individual capillaries

are spaced apart by a small distance. (See Figure 10 and Col. 1, Lines 50-55) The module further teaches the bottom of the capillaries is securely embedded in a support/end plate (29) for “close packing” in order to provide a sufficient space between each capillary and thus ensuring a gas passage from the outside to the inside of the capillary. (See Col. 2, Lines 5-20)

It would have been obvious to a person of ordinary skill in the art to provide end plates as disclosed in Taketomo to provide a sufficient space between each capillary and thus ensuring a gas passage from the outside to the inside of the capillary.

3. **Claims 13-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalthod (US 5,779,897) in view of McGinnis (US 3690465) and further in view of Garcera (US 4640774) as applied to claim 27 above, and further in view of Shay (US 4310607).

Refer above for the teachings of Kalthod, McGinnis and Garcera.

Kalthod, McGinnis and Garcera fail to teach the housing consists of stainless steel.

Shay teaches a separator bundle comprising a bundle of capillary fibers. Shay further teaches a stainless steel housing (34) that encloses the bundle of capillary fibers.

It would have been obvious to a person of ordinary skill in the art to modify the device of Kalthod in view of McGinnis to provide a stainless steel housing enclosing the bundle in order to use the separator module in a battery cell as disclosed in Shay.

4. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kalthod (US 5,779,897) in view of McGinnis (US 3690465) and further in view of Garcera (US 4640774) as applied to claim 27 above, and further in view of Bellhouse (US 6217764).

Refer above for the teachings of Kalthod, McGinnis and Garcera.

Kalthod, McGinnis and Garcera fail to teach a ceramic housing.

Bellhouse teaches filtration module. Bellhouse teaches a filter comprising a large number of parallel capillaries in a highly porous block of support material/housing. (See Col. 1, Lines 27-29)

It would have been obvious to a person of ordinary skill in the art to modify the device of Kalthod in view of McGinnis to provide a ceramic housing as disclosed in Bellhouse in order ensure radial mixing and hence optimum filtration.

5. **Claim 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kalthod (US 5,779,897) in view of McGinnis (US 3690465) and further in view of Garcera (US 4640774) as applied to claim 27 above, and further in view of Dobo (US 4268278).

Refer above for the teachings of Kalthod, McGinnis and Garcera.

Kalthod, McGinnis and Garcera fail to teach a separation module comprising a catalyst.

Dobo teaches fluid separation module comprising hollow fibers. The separation module further comprising a catalyst. (See Col. 1, Lines 1-65)

It would have been obvious to a person of ordinary skill in the art to modify the device of Kalthod in view of McGinnis to provide a separation module with a catalyst in order to obtain desired reactions and enhance separation as disclosed in Dobo.

Response to Arguments

6. Applicant's arguments with respect to claims 2, 4-11, 13-16 and 26-27 have been considered but are moot in view of the new ground(s) of rejection. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In response to applicants' arguments that there is no suggestion to combine references, the examiner recognizes that references cannot be arbitrarily combined and there must be some reason why one skilled in the art would be motivated to make the proposition combination of references. However, there is no requirement that a motivation to make the modifications be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole suggest to one of ordinary skill in the art. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI NAGPAUL whose telephone number is (571)272-1273. The examiner can normally be reached on Monday thru Friday (10:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jyoti Nagpaul/
Examiner, Art Unit 1797